



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/688,075

10/17/2003

Thomas Huber

2050.085US1

8165

44367

7590

05/14/2009

SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV

P.O. BOX 2938

MINNEAPOLIS, MN 55402-0938

EXAMINER

THOMAS, JASON M

ART UNIT

PAPER NUMBER

2423

NOTIFICATION DATE

DELIVERY MODE

05/14/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com

scape@slwip.com

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/688,075 | Applicant(s) HUBER ET AL. | |
| | Examiner Jason Thomas | Art Unit 2423 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, see pg. 9-16, filed April 14, 2009, with respect to the rejection of claims 1-16 under 35 U.S.C. section 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of Matz, U.S. Pub. No. 2004/0261096 A1, Allen, U.S. Pub. No. 2004/0078814 A1, Miller, U.S. Pat. No. 7,266,832 B2 and Hord et al., U.S. Pub. No. 2004/0034874 A1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matz, U.S. Pub. No. 2004/0261096 A1 (hereinafter Matz), in view of Allen, U.S. Pub. No. 2004/0078814 A1 (hereinafter Allen), Miller, U.S. Pat. No. 7,266,832 B2 (hereinafter Miller), Hord et al., U.S. Pub. No. 2004/0034874 A1 (hereinafter Hord) and Pudar, U.S. Pub. No. 2002/0184091 A1 (hereinafter Pudar).

Regarding claim 1: Matz teaches a method of presenting advertising in a subscriber broadcast system, the method comprising: providing indicators for

Art Unit: 2423

content wherein said indicators include metadata which describes the content type (see [13], [15], [45], [49], [82] for a broadcasting system designed to tag content prior to being broadcast to client devices which is inclusive of advertisements and other content items) and wherein set top box computer program code is to: compare the first category indicator and the second category indicator to a stored category value and select said second advertisement when a second category indicator corresponds to said stored category value (see [76], [85], [112], [115] where each ad content item received is compared to a stored category or weight value based on a viewer profile) but does not teach: offering an upgraded advertising service; receiving subscriptions to said upgraded advertising service; delivering set top box computer program code to a plurality of set top boxes, receiving a plurality of video feeds including a plurality of advertisements; including a priority indicator; or comparing the first priority level indicator and the second priority level indicator; and select said second advertisement when the second category indicator corresponds to said stored category value and the second priority level indicator is greater than or equal to said first priority level indicator.

Allen teaches a broadcasting system where a head-end component receives a plurality of video feeds including a plurality of advertisements (see [fig. 1], [29]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the head-end of a cable service provider, as taught by Matz by including a means to receive a plurality of video feeds which include a plurality of ads, as taught by Allen, in order for the user to have a wide

variety of content including ads to select from to compensate for the content which is blocked indicating that is not of any interest to the user (see [6], [13]).

Miller teaches offering upgraded advertising services and receiving subscriptions to said upgraded advertising services from viewers (see [abstract], [col. 10, ll. 7-22] where the subscriber must be opted-in to receive an ad substitution service, which reads on an upgraded service). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of presenting desired content to the viewer by providing viewers with an option to opt-in to receive interactive or substitute ads, as taught by Miller in order to provide viewers with the option to have a more interactive and user controlled viewing experience.

Hord teaches downloading software to a receiver device for the purpose of enabling the receiver to perform additional functions, which may not be available to the current user, as requested by the user or in response to a message from the headend (see [3], [28], [46], [50]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the receiving device by enabling it to receive computer program code to add additional functionality with respect to advertising services, as taught by Hord, in order to modify the operation of the client device by providing additional services to enhance the subscriber's experience.

Pudar teaches a broadcasting system where the ads to be inserted into the primary programming contain category and priority indicators associated with each

Art Unit: 2423

individual ad; wherein a first and subsequent (second) ad can be compared, with respect to their priority, to determine which is to be inserted based on the priority level (see [fig. 7-9], [29], [34], [35] where ad content with a relatively high priority would be selected over a relatively lower priority, which reads on a second priority level indicator which is greater than or equal to a first priority level indicator).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the receiving device of Matz by providing an alternate means of substituting ad content based on priority information included in the metadata as taught by Pudar in order to maximized revenue by choosing the higher priced advertisements from among competing candidate advertisements for a particular advertising slog (see [29]).

Regarding claim 2: The combined teachings of Matz, in view of Allen, Miller, Hord and Pudar, teach receiving a request for an advertising category from at least one subscriber (see Matz [fig. 11]).

Regarding claim 3: The combined teachings of Matz, in view of Allen, Miller, Hord and Pudar, teach broadcasting an advertising indicator that can be retrieved using a network address (see Miller [col. 2, ll. 49-67] where ads can include interactive triggers such as URL address).

Regarding claim 4: The combined teachings of Matz, in view of Allen, Miller, Hord and Pudar, teach downloading an advertisement and corresponding indicator to local storage of a set top box (see Matz [60], [65], [108] for storing tag and content information at the set top device).

Regarding claim 5 The combined teachings of Matz, in view of Allen, Miller, Hord and Pudar, teach selecting said plurality of advertisements based upon demographic characteristics of said plurality of set top boxes (see Matz [46] for associating tags with user classification s such as user demographics or usage patterns based on generalized demographic information).

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matz, in view of Miller and Pudar.

Regarding claim 6: Matz teaches a method for displaying user selected advertising in a subscriber broadcast system, the method comprising: requesting a category of advertisement from a plurality of advertisement categories, the category being selected by a subscriber, the selected category of advertisement having an associated stored category value (see [fig. 11], [120] for selecting a category; see [95] where each category may have a stored associated value or weight); receiving a video signal comprising program content, a standard advertisement and an advertisement indicator, wherein said advertisement indicator indicates a weight and a category valued for an advertisement corresponding to the category (see [fig. 5-6], [13] for receiving video content and ads with the associated tag (indicator) describing the content received) however Matz does not teach including a “priority” level indicator or determining if a standard advertisement may be replaced with an upgraded advertisement; accessing upgraded advertisement content if it is determined that said standard advertisement may be replaced with an upgraded advertisement, wherein the upgraded advertisement content includes a first

Art Unit: 2423

advertisement and a second advertisement, and wherein a first advertisement indicator including a first priority level indicator and a first category indicator is associated with the first advertisement and a second advertisement indicator including a second priority level indicator and a second category indicator is associated with the second advertisement; selecting between said first advertisement and said second advertisement by: comparing the first category indicator and the second category indicator to a stored category value; comparing the first priority level indicator and the second priority level indicator; and selecting said second advertisement when the second category indicator of said second advertisement corresponds to said stored category value and the second priority level indicator is greater than or equal to said first priority level indicator; and displaying the selected advertisement.

Miller teaches accessing upgraded advertising services and receiving subscriptions to said upgraded advertising services from viewers (see [abstract], [col. 10, ll. 7-22] where the subscriber must be opted-in to receive an ad substitution service, which reads on an upgraded service). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of presenting desired content to the viewer by providing viewers with an option to opt-in to receive interactive or substitute ads, as taught by Miller in order to provide viewers with the option to have a more interactive and user controlled viewing experience.

Pudar teaches a broadcasting system where default ads can be replaced with an upgraded advertisement, in that the substituted ad is based on a user's interests rather than a generic ad broadcasted to a general audience, to be inserted into the primary programming contain category and priority indicators associated with each individual ad; wherein a first and subsequent (second) ad can be compared, with respect to their priority, to determine which is to be inserted based on the priority level to replace a standard (default) advertisement (see [fig. 7-9], [23], [29], [34], [35] where ad content with a relatively high priority would be selected over a relatively lower priority, given it is an appropriate category, which reads on a second priority level indicator which is greater than or equal to a first priority level indicator). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the receiving device of Matz by including a method to provide upgraded advertisement content based on a user's profile using on category and priority information included in the metadata of the ad content as taught by Pudar in order to better target ads to users that better suite their interest (see [5]).

3. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, in view of Pudar and Dudkiewicz et al., U.S. Pat. No. 6,973,665 B2 (hereinafter Dudkiewicz).

Regarding claims 7 and 14: Miller teaches an upgraded advertising production system (see [abstract] for opted-in subscribers receiving the ability to receive advertisement swapping services) comprising: a processor (see [col. 3, ll. 1-

Art Unit: 2423

20], [col. 7, ll. 14-30] for having the ability to process using processors at a head-end device); an advertisement detector to receive a video feed comprising program content and advertising (see [fig. 1, item 16], [col. 3, ll. 1-20], [col. 10, ll. 7-22], [col. 12, ll. 7-33] for a device within the head-end capable of receiving a video feed comprising program content and ads); and a channel multiplexer to receive said program content, at least one ad and said at least one ad indicator and to format said program content, said at least one ad and said at least one ad indicator for transmission and a transmitter to transmit (see [col. 3, ll. 43-60] for multiplexing data prior to streaming; see also [col. 3, ll. 21-42], [col. 6, ll. 51-62] for a transmitter to transmit programming, ads and ad indicators to an end user device) but does not teach an indicator (supplemental data) which includes a priority level indicator and a category indicator for a corresponding advertisement to allow a computer program code to compare a first category indicator associated with a first advertisement and a second category indicator associated with a second advertisement to a stored category value, compare a first priority level indicator associated with said first advertisement with a second priority level indicator associated with said second advertisement, and select said second advertisement when the second category indicator corresponds to said stored category value and said second priority level indicator is greater than or equal to said first priority level indicator or an advertisement indicator editor configured to create, modify and delete at least one ad indicator associated with an advertisement.

Pudar teaches a broadcasting system where default ads can be replaced with an upgraded advertisement, in that the substituted ad is based on a user's interests rather than a generic ad broadcasted to a general audience, to be inserted into the primary programming contain category and priority indicators associated with each individual ad; wherein a first and subsequent (second) ad can be compared, with respect to the category and priority indicators, to determine which is to be inserted based on the category and priority level to replace a standard (default) advertisement (see [fig. 7-9], [23], [29], [34], [35] where ad content with a relatively high priority would be selected over a relatively lower priority, given it is an appropriate category, which reads on a second priority level indicator which is greater than or equal to a first priority level indicator). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the receiving device of Matz by including a method to provide upgraded advertisement content based on a user's profile using a first program (function) to compare category and priority information included in the metadata of the ad content and a second program (function) to present ad which is best suited to be used as a substitute ad, as taught by Pudar in order to better target ads to users that better suite their interest (see [5]).

Dudkiewicz teaches using programming indicators which include category indicators to describe the program and an editor that can create, modify and delete metadata containing indicator information for at least one programming indicator associated with the programming contained in said video feed (see [cols., 13-14, ll.

Art Unit: 2423

66-36]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the head-end system by including a means to create, modify and delete indicator information as taught by Dudkiewicz in order to provide a means for users with proper access to add, delete or change descriptive information as needed to better describe the programming content (see [cols. 13-14, ll.66-36]).

4. Claims 8, 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, in view of Pudar.

Regarding claims 8 and 15: Miller teaches a set top box to selectively display upgraded advertising (see [abstract] for opted-in subscribers receiving the ability to receive advertisement swapping services) comprising: a processor (see [cols. 3-4, ll. 61-14], [cols. 9-10, ll. 64-6] for processors); an audio/video processor to output audio and video signals to a display unit (see [fig. 1, 34], [cols. 3-4, ll. 61-14] where audio/video processing and a audio/video processor is inherent in the process of sending the received signals containing audio/video to a television); and a tuner controlled by said processor to receive a video input comprising program content, ads and ad indicators (see [col. 9, ll. 22-35] for switching or adjusting the tuner of a STB to a specific channel to receive substitute ads and associated data) but does not teach ads which include priority level indicators and category indicators such that programming is in place to compare a first and second category indicator to a stored category value and compare the first and second priority level indicator to select an ad with a desired category indicator and priority level indicator which is greater than

Art Unit: 2423

or equal to an ad with a lesser priority indicator and as a result providing either the first or second ad which fulfills the specified criteria indicated by the category and priority information.

Pudar teaches a broadcasting system where default ads can be replaced with an upgraded advertisement, in that the substituted ad is based on a user's interests rather than a generic ad broadcasted to a general audience, to be inserted into the primary programming contain category and priority indicators associated with each individual ad; wherein a first and subsequent (second) ad can be compared, with respect to the category and priority indicators, to determine which is to be inserted based on the category and priority level to replace a standard (default) advertisement (see [fig. 7-9], [23], [29], [34], [35] where ad content with a relatively high priority would be selected over a relatively lower priority, given it is an appropriate category, which reads on a second priority level indicator which is greater than or equal to a first priority level indicator, where it is well known in the art that programs can be broken down into individual functions, routines or modules to perform independent but related tasks). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the receiving device of Matz by including a method to provide upgraded advertisement content based on a user's profile using a first program (function) to compare category and priority information included in the metadata of the ad content and a second program (function) to present ad which is best suited to be used as a

Art Unit: 2423

substitute ad, as taught by Pudar in order to better target ads to users that better suite their interest (see [5]).

Regarding claims 11 and 12: The combined teachings of Miller, in view of Pudar, teach code which is inherent in the operation of a STB for adjusting a tuner to receive ads and acquiring ads across a network (see Miller [fig. 1], [col. 9, ll. 22-35] for switching or adjusting the tuner of a STB to a specific channel to receive substitute ads and associated data and where doing so is a part of acquiring ads across a network).

Regarding claim 13: The combined teachings of Miller, in view of Pudar, teach a video combiner to combine a portion of said first ad with a portion of said second ad (see Miller [col. 9, ll. 22-35] for combining video using picture-in-picture arrangements).

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, in view of Pudar and Matz.

Regarding claim 9: The combined teachings of Miller, in view of Pudar, do not teach a set top box capable to process a user input and store said stored category value in said set top box.

Matz teaches a feature which allows the user to select/input a preferred advertisement category and save the input to be used as a part of the preferred advertisement selection process (see [fig. 11], [120], [121]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 2423

modify the STB by allowing users to directly input his/her interest as taught by Matz in order to provide ads which may be more closely related to the user's interest.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, in view of Pudar and Wachob, U.S. Pat. No. 5,155,591 (hereinafter Wachob).

Regarding claim 10: Neither Miller nor Pudar teach computer program code that recognizes a remote control input as being specific to one user and selects said stored category value from a plurality of stored category values based upon an identifier of said one user.

Wachob teaches means implicit of executable instructions that recognize a remote control input as being specific to one user and selects said stored category value from a plurality of stored category values based upon an identifier of said one user (see [figs. 2 & 4], [col. 1, ll. 48-55], [col. 2, ll. 10-23], [col. 2, ll. 37-42]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the set top box device by providing a means for identifying multiple users, as taught in Wachob, in order to allow multiple viewers with differing preference to live in the same location and use the same display apparatus while still maintaining information unique to each viewer (see Wachob [col. 2, ll. 13-17], [col. 2, ll. 37-40])..

7. Claims 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, in view of Pudar and Matz.

Regarding claim 16: Miller teaches a system for the transmission and reception of ads for viewing but does not teach tracking and billing.

Matz teaches defining a plurality of ad categories and receiving user request for said ad categories (see [fig. 11]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the STB by allowing users to directly input his/her interest as taught by Matz in order to provide ads which may be more closely related to the user's interest.

Pudar teaches the tracking of ads where detailed information regarding the ads played is recorded, including keeping a count of how many times a particular ad was played, and teaches knowing the category data of each particular ad which is tracked, in addition to creating billing information, which reads on a statement, which is returned to a central facility to bill advertisers (see [abstract], [31], [34], [38]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify such a dynamic ad system by including a means of billing advertisers for the ads which were actively used as taught by Pudar in order to keep an accurate account of the consumption of advertisement material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Thomas whose telephone number is (571) 270-5080. The examiner can normally be reached on Mon. - Thurs., 8:00 a.m. - 5:00 p.m..

Art Unit: 2423

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. Thomas

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2423